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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,334	11/09/2001	Hidekazu Nakai	275788US6	5902

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

SCUDERI, PHILIP S

ART UNIT PAPER NUMBER

2153

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	05/01/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 05/01/2007.

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patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/037,334	<b>Applicant(s)</b> NAKAI, HIDEKAZU	
	<b>Examiner</b> Philip S. Scuderi	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments, see pages 7-8, filed 13 March 2007, with respect to the rejection(s) of claim(s) 1-6 under §102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 8 recites a "means for controlling to download required data ... and store the data", which doesn't make grammatical sense to the point of rendering the scope of the claim indefinite. The examiner's best understanding is that applicant meant for the limitation to read, "means for controlling a download of required data ... and storing the data." The examiner will treat the claim on the merits as best understood.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3-5, 7, and 10-12 rejected under 35 U.S.C. 102(e) as being anticipated by**

**Hosoe (U.S. Patent No. 6,047,376).**

As to claim 1, Hosoe teaches a recording medium, comprising:

a first storage region wherein program information (first program) describing a procedure for executing a connection to a predetermined server (38) over a predetermined communication network (100) and downloading data from the connected server (38), is stored [see fig. 2 and col. 8, ll. 22-38 (first program is stored on the medium)];

a second storage region into which the data can be written (any writable storage region) [see fig. 2 and col. 4, ll. 49-65 (the memory medium can be writable)]; and

a third storage region having an ID (identification number) unique to said recording medium stored therein [see fig. 2].

As to claims 3-5, the ID (identification number) can be utilized by said server (38) to manage accounting for the downloaded data, identify a type of the download data, or supply source of the download data [see col. 6, ll. 41-49]. Note that to meet these claims the server only needs to be capable of utilizing the ID to manage accounting etc.

As to claim 7, Hosoe teaches a recording apparatus, comprising:

a readout unit configured to read out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server (38), the unique ID (identification number) is information which

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can be utilized by the server to manage accounting for the downloaded data [see fig. 2 and col. 8, ll. 22-38 (first program is stored on the medium)];

a memory configured to be able to store data [see fig. 2 and col. 4, ll. 49-65 (the memory medium can be writable)];

a controller configured to control (capable of controlling) downloading required from the server (38) in accordance with the read out program information (first program), and store the data acquired by the downloading with identification information indicating a relationship to the program information into the memory [see fig. 2].

As to claim 10, Hosoe teaches a playback apparatus comprising:

a readout unit configured to read out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server (38), the unique ID (identification number) is information which can be utilized by the server (38) to manage accounting for the downloaded data [see fig. 2].

a memory configured to store content data with identification information indication a relationship to the program information [see fig. 2 and col. 4, ll. 49-65 (the memory medium can be writable)]; and

a controller configured to playback the content data based on the read out program information [see fig. 2].

As to claim 11, Hosoe teaches a playback apparatus comprising:

means for reading out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a

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procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server, the unique ID (identification number) is information which can be utilized by the server (38) to manage accounting for the downloaded data [see fig. 2 and col. 8, ll. 22-38 (first program is stored on the medium)];

means for storing content data (e.g., music) with identification information (identification number) indicating a relationship to the program information (stored on the same media) [see fig. 2]; and

means for playback of the content data (e.g., music) based on the read out program information (e.g., based on information obtained from a music information service using the first program) [see fig. 2 and col. 7, ll. 29-54].

As to claim 12, Hosoe teaches a playback method for a playback apparatus having a memory comprising:

a readout step of reading out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server (38), the unique ID (identification number) is information which can be utilized by the server to manage accounting for the downloaded data [see fig. 2];

a playback step of playback content data (e.g., music) with identification information (identification number) indicating a relationship to (stored on the same media) the program information (first program) from the memory based on the read out program information (e.g., based on information obtained from a music information service using the first program) [see fig. 2 and col. 7, ll. 29-54].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoe (U.S. Patent No. 6,047,376).**

As to claim 6, Hosoe teaches a downloading method, comprising:

a readout step of reading out program information (first program), from a recording medium having a first storage region wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) over a predetermined communication network (100) and downloading data from the connected server (38) is stored, a second storage region into which the data can be written, and a third storage region having an ID (identification number) unique to said recording medium stored therein [see fig. 2 and col. 8, ll. 22-38 (first program is stored on the medium)];

an access step of accessing said server (38) in accordance with the read out program information (first program) [see fig. 2]; and

a download step of downloading required data from said server (38) accessed in accordance with the read out program information (first program) [see fig. 2].

Hosoe does not expressly disclose storing the data acquired by the downloading into the second storage area of the storage medium.

Hosoe discloses that the medium can be a writable medium [see col. 4, ll. 49-65]. It would have been obvious to one of ordinary skill in the art to store the data acquired by the download on the medium because the data acquired is data that is desired by the user of the medium [see col. 7, ll. 36-39].

As to claim 8, Hosoe teaches a recording apparatus, comprising:

- means for reading out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server (38), the unique ID (identification number) is information which can be utilized by the server (38) to manage accounting for the downloaded data [see fig. 2 and col. 8, ll. 22-38 (first program is stored on the medium)];

- means for storing data [see fig. 2 and col. 4, ll. 49-65 (the memory medium can be writable)];

- means for controlling a download of required data from the server (38) in accordance with the read out program information (first program) [see fig. 2].

Hosoe does not expressly disclose means for storing the data acquired by the downloading with identification information indicating a relationship to the program information into the memory.

Hosoe discloses that the medium can be a writable medium [see col. 4, ll. 49-65]. It would have been obvious to one of ordinary skill in the art to provide a means for storing the data acquired by the download on the medium because the data acquired is data that is desired by the user of the medium [see col. 7, ll. 36-39]. Storing the acquired data on the medium would store the acquired data with identification information (the identification number) indicating a relationship to the program information (stored on the same medium).



As to claim 9, Hosoe teaches a recording method for a recording apparatus having a memory, comprising:

a readout step of reading out program information (first program) and a unique ID (identification number) from a recording medium, wherein the program information (first program) describes a procedure for executing a process for establishing a connection to a predetermined server (38) and downloading data from the server (38), the unique ID (identification number) is information which can be utilized by the server (38) to manage accounting data for the downloaded data [see fig. 2 and col. 8, ll. 22-38 (first program is stored on the medium)]; and

a downloading step of downloading required data from the server (38) in accordance with the read out program information (first program) [see fig. 2].

Hosoe does not expressly disclose storing the data acquired by the downloading with identification information indicating a relationship to the program information into the memory.

Hosoe discloses that the medium can be a writable medium [see col. 4, ll. 49-65]. It would have been obvious to one of ordinary skill in the art to provide a means for storing the data acquired by the download on the medium because the data acquired is data that is desired by the user of the medium [see col. 7, ll. 36-39]. Storing the acquired data on the medium would store the acquired data with identification information (the identification number) indicating a relationship to the program information (stored on the same medium).

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PS

  
GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100